

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIMS	STATUS	DEPENDENCY
1	Previously presented	1
2	Previously presented	2
3	Previously presented	2
4	Previously presented	2
5	Previously presented	2
6	Canceled	—
7	Currently amended	28
8	Currently amended	28
9	Currently amended	28
10	Previously presented	1
11	Previously presented	10
12	Previously presented	10
13	Previously presented	1
14	Previously presented	13
15	Previously presented	1
16	Previously presented	10
17	Previously presented	10
18	Previously presented	10
19	Currently amended	Independent
20	Previously presented	19

Claims	STATUS	DEPENDENCY
21	Previously presented	20
22	Previously presented	19
23	Previously presented	19
24	Previously presented	19
25	Currently amended	19
26	Previously presented	19
27	Previously presented	19
28	New	Independent

Comments of Examiner Leo T. HINZE have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatises and relevant decisional law. In accordance with Examiner HINZE's requirements, allowance of the Application, as amended, is solicited earnestly.

The Examiner has stated:

Claim 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action.

Claims 20-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

Claims 6-9 are objected to as being dependent upon a rejection base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Accordingly, claims 19-27 have been amended in accordance with the Examiner's comments. Claims 19-27 as amended are believed to be patentable.

Claim 6 has been canceled and the subject matter of claim 6 has been presented in new Claim 28 which includes the limitations of the base claim. Claims 7-9 have been amended to depend from new claim 28. New Claim 28 and Claims 7-9, as amended are believed to be patentable.

Claims 1-5 and 13-15 have been rejected under 35 USC 103(a) as being unpatentable over *Fang* US 6,536,941 in view of *Yamamoto* US 5,615,179.

Claims 10-12 and 16-18 have been rejected under 35 USC 103(a) as being unpatentable over *Fang* in view of *Yamamoto* and further in view of *Kondo* US 5,894,454.

Reconsideration of the Examiners rejection of Claims 1-5 and 10-18 is requested on the following basis and Examination of the *Fang*, *Yamamoto* and *Kondo* patents reveals the following differences between the structure shown therein, the structure of the present invention and the statements of the Examiner.

1. *Fang* teaches a wrist-worn personal flash disk comprising:

a main body having a first enclosure and a second enclosure;

a memory module set into the first enclosure, wherein the memory module is connected with a data line;

a strap set composed of a first strap and a second strap, wherein the first strap and the second strap are extended out in opposite directions to each other from the lateral sides of the main body, wherein the data line is enclosed in the first strap and an interfacing connector is mounted on one end of the first strap for adapting to connect with a host computer, wherein the interfacing connector is connected to the memory module via the data line; and

an accessory receivable in the second enclosure of the main body.

2. In *Fang's* invention, the connection cable and the USB connector are fixed and the data line is enclosed in the first strap. It is apparent that *Fang's* invention is difficult to produce, difficult to maintain and difficult to change the data line and the USB connector.

3. In contrast to *Fang*, in the present invention, the connection cable and the USB connector can be easily separated from the watch band. It is convenient to replace the USB connector assembly of the present invention when repairing or maintaining as needed.

There is no teaching in the *Fang*, *Yamamoto* and *Kondo* references taken alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the *Fang*, *Yamamoto* and *Kondo* references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 1897 (Fed. Cir., 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles reads as follows:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) “ought to be tried” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220, USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues herein involved.

It is submitted that the Examiner’s position in applying *Fang, Yamamoto* and *Kondo* contrary to the above-quoted tenets of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant’s invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention;; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg., Co.* 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake”. *Hybrietch, Inc. v. Monocionoal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant's invention from selecting bits and pieces from *Fang*, *Yamamoto* and *Kondo*. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person of ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the art never created wristwatch capable of storing and transmitting data comparable to Applicant's. See *Id* at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant's invention is not obvious. *Continental Can*, 948 F2d at 1273.

The status of the Claims is as follows:

Claims 1-5, 10-18, 20-24 and 26-27 are original.

Claim 6 has been canceled.

Claim 7-9, 19-25 have been amended.

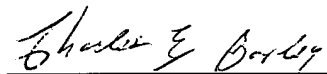
Claim 28 is new.

It is believed that Claims 1-5 and 7-28 are patentable.

In view of the foregoing submissions and explanations, it is believed that Claims 1-5 and 7-28 are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

Courtesy, cooperation and skill of Examiner Leo T. HINZE are appreciated and acknowledged.

Respectfully,



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